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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,583	11/17/1998	TETSURO MOTOYAMA	5244-0084-2X	9978
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HO, CHUONG T	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/192,583

Applicant(s)

MOTOYAMA, TETSURO

Examiner

CHUONG T. HO

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/15/05</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2664

1. The amendment filed 08/03/05 have been entered and made of record.
2. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1-53 is pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-10, 12-15, 23-26, 31-32, 34-37, 45-46, 48, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (U.S. Patent No. 6,219,694 B1) in view of Kuwabara (U.S. Patent No. 6,065,136).

In the claims 1, 23, Lazaridis et al. discloses determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); A list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent

Art Unit: 2664

from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

- Receiving an electronic mail message by a computer; determining whether a content of the message (the word "instruction" is the characteristic of the e-mail) is for a user (user's desktop system 10) or for an attached device (a mobile data communication device) associated with the computer by detecting a characteristic of the e-mail, the attached device being a business office device (a mobile data communication device) including a processor (see abstract, col. 8, lines 9-11);
- transmitting a communication from the computer (user's desktop system 10) to the attached device (a mobile data communication device) (see abstract, determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message);

- operating the processor of the attached device (a mobile data communication device) in response to the communication (once the message (A or B) is received by the mobile device 24), the outer envelope B is removed and the original message A is placed in the secondary memory store within the mobile device 24. By repacking and removing the outer envelope in this manner, the present invention causes the mobile computer 24 to appear to be at the same physical location as the host system 10, thus creating a transparent system).

However, Lazaridis et al. is silent to disclosing determining whether a content of the received message related to monitoring or control of an attached device associated with the computer; transmitting a communication from the computer to the attached device, if the determining step determines that the received message is not for the user.

Kuwabara discloses determining whether a content of the received message ("the address mail code", see col. 5, lines 32-37) related to monitoring or control of an attached device associated with the computer; transmitting a communication from the computer to the attached device, if the determining step determines that the received message is not for the user.

Both Lazaridis et al. and Kuwabara discloses determining the characteristics of the e-mail message, and forwarding the e-mail messages to the device. Kuwabara recognizes determining whether a content of the received message ("the address mail code", see col. 5, lines 32-37) related to monitoring or control of an attached device associated with the computer; transmitting a communication from the computer to the attached device, if the determining step determines that the received message is not for

Art Unit: 2664

the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Lazaridis with the teaching of Kuwabara to determine whether a content of the received message related to monitoring or control of an attached device associated with the computer; transmitting a communication from the computer to the attached device, if the determining step determines that the received message is not for the user in order to diagnose of troubles in such devices.

6. In the claims 2, 24, 34, Lazaridis et al. discloses determining whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) for operating the device or whether the received message which has been received has been received has a user of the computer as an end recipient (see abstract, col. 8, lines 9-11).

7. In the claims 3, 25, Lazaridis discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the displayed message whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) is for operating the device (see abstract, col. 8, lines 9-11).

8. In the claim 8, Lazaridis et al. discloses receiving an Internet electronic mail message (see abstract, col. 8, lines 9-11, figure 1).

9. In the claim 12, Lazaridis et al. discloses determining whether the message is for the user (the user's desktop system 10) or for the attached device automatically by

detecting a characteristic (the word "instruction" is the characteristic of the e-mail) (see abstract, col. 8, lines 9-11).

10. In the claim 45, Lazaridis et al. discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message (repackage the user-selected data items in an electronic wrapper prior to push the data items to the mobile device) by computer (the user's desktop system 10) including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer.

11. In the claims 46, 31, 50, 51, Lazaridis et al. discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see col. 1, lines 11-15, the system and method of the present invention provide an event-driven redirection computer program ("redirector program") operating at the host system, which, upon sensing a particular user-defined event has occurred, redirects user-selected data items from the host system to the user's mobile data communication device (Business office device including CPU) (col. 7, lines 14-15).

12. In the claims 4, 48, 26, 32, Kuwabara, see figure 1, discloses receiving an electronic mail message by a computer (the provider 5); determining whether the received e-mail includes instruction (addressee mail code column ML1 that it has been addressed to the marker's provider (a business office device)) for operating a device (the marker's provider 8) associated with computer (the provider 5), the device (the marker's provider 8) being a business office device including a processor; comprising:

Art Unit: 2664

Executing a command which causes the step of transmitting to be performed (see col. 5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the computer) identifies from its addressee mail code column ML1 (execute program code) that it has been addressed to the marker's provider 8 (the business office devices) through a telephone line T4 considered to be the optimum route).

13. In the claims 9, 27, Lazaridis discloses the step of executing a command comprises transmitting information to a device driver executing within the computer; and step of transmitting is performed using the device driver (see col. 1, lines 13-16).

14. In the claim 10, Lazaridis discloses receiving, by the device, the communication transmitted from the computer; and transmitting parameters from the device to the computer, in response to the communication which has been received by the device (see col. 6, lines 42-45).

15. In the claims 13, 35, 36, 37, 52, Kuwabara discloses determining that the message for operating the attached device automatically by detecting a code within the message (see col. 5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the computer) identifies from its addressee mail code column ML1 (execute program code) that it has been addressed to the marker's provider 8 (the business office devices) and serves to transmit it to the address provider 8 (the business office devices) through a telephone line T4 considered to be the optimum route).

16. In the claim 14, Kuwabara discloses determining that the message for operating the attached device automatically by detecting a code within the message (see col. 5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the

Art Unit: 2664

computer) identifies from its addressee mail code column ML1 (executing program code) that it has been addressed to the marker's provider 8 (the business office devices) and serves to transmit it to the address provider 8 (the business office devices) through a telephone line T4 considered to be the optimum route).

17. In the claim 15, Kuwabara discloses determining that the message is for the attached device automatically by detecting a code within the message (see col. 5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the computer) identifies from its addressee mail code column ML1 (executing program code) that it has been addressed to the marker's provider 8 (the business office devices) and serves to transmit it to the address provider 8 (the business office devices) through a telephone line T4 considered to be the optimum route).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 5-7, 11, 16-17, 27-29, 30, 47, 33, 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Kuwabara) in view of Zerber (U.S.Patent No. 5,951,636).

In the claims 5, 6, 7, 27, 33, the combined system (Lazaridis – Kuwabara) discloses the limitations of claim 1 above.

However, the combined system (Lazaridis – Kuwabara) is silent to disclosing the executing program code of a file which is attached to the message by a manual action by the user.

Zerber discloses executing program code of a file which is attached to the message by a manual action by the user (see abstract).

Both Lazaridis, Kuwabara, and Zerberman discloses e-mail message. Zerberman discloses executing program code of a file which is attached to the message by a manual action by the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis – Kuwabara) with the teaching of Zerberman to executing program code of a file which is attached to the message by a manual action in order to limit to only those messages the user want to downloaded.

20. Regarding to claims 6, 29, Zerberman et al. discloses executing the program code of the file by pointing, using a pointing device and graphical user interface, to an object representing the file (see abstract).

21. Regarding to claims 7, 28, Zerberman et al. discloses executing the code by pressing a button while pointing the object representing the file (see abstract).

22. Regarding to claim 11, Zerberman et al. performing a mechanical action by the device, in response to the communication which has been received by the device (see abstract).

Art Unit: 2664

23. Regarding to claims 16, 17, 30, 38, 39, Zerber et al. discloses the determining step is performed in response to a receipt of an incoming electronic mail message (see col. 2, lines 30-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Kuwabara) in view of Miyachi (U.S. Patent No. 6,108,492).

Regarding to claim 47, the combined system (Lazaridis - Kuwabara) discloses the limitations of claim 1 above.

However, the combined system (Lazaridis - Kuwabara) is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

Both Lazaridis, Kuwabara, and Miyachi disclose the office device. Miyachi discloses the business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Thus, it would have been obvious

Art Unit: 2664

to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis - Kuwabara) with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 18, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara (U.S. Patent No. 6,065,136) in view of Chapman et al. (U.S. Patent No. 6,522,421 B2).

Regarding to claims 18, 40, see figure 1, Kuwabara discloses transmitting device status (see col. 5, lines 15-17) information from a device (main part 11) to a computer (computer part C1) attached to the device (main part 11); comprising:

- processing device status (see figure 2, 14a, 14b, 14c) col. 5, lines 1-12) by a device driver (14a, 14b, 14c) within the computer (the computer part C1); and
- transmitting, by the computer (the computer part C1), an electronic message including the processed status information (see col. 5, lines 1-11);

Art Unit: 2664

- Wherein the device driver (see col. 1, lines 11-15) is configured to translate signals received from the device (main part 11) into signals transmitted to an email processor of the computer (computer part C1).

However, Kuwabara is silent to disclosing the device being a business office device including a processor.

Chapman discloses transmitting device status information (see col. 3, lines 5-6) from a device (printers 15', 15") to a computer (30) attached to the device (printers, see col. 3, lines 5-6), the device (printer, see col. 3, line 60, the printer include a computer controller that can send and receive a stream of bytes compressed data representing an image) including a processor.

Both Kuwabara, and Chapman discloses device status information. Chapman recognizes the device being a business office device including a processor. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kuwabara to provide the device including a processor in order to send out the status information to the user via e-mail.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2664

27. Claims 19-22, 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Kuwabara – Chapman) in view of Lazaridis et al. (U.S. Patent No. 6,219,694 B1).

Regarding to claims 19, 41, the combined system (Kuwabara – Chapman) discloses the limitations of claims 18, 40 above.

However, the combined system (Kuwabara – Chapman) is silent to disclosing transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI.

Lazaridis et al. discloses transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI (see col. 7, lines 31-45).

Both Kuwabara, Chapman, Lazaridis discloses the an electronic message transmitting from computer to device. Lazaridis recognizes transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI. Thus, it would

Art Unit: 2664

have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Kuwabara – Chapman) with the teaching of Lazaridis to transmit transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI in order to delivery of the data items from the host system of the device.

28. Regarding to claims 20, 42, Lazaridis et al. discloses the computer is a message transfer agent, the step of transmitting information from the device transmit the information from the device directly to the computer which is the message transfer agent, and the step of transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent (see col. 8, lines 32-35).

29. Regarding to claims 21, 43, Lazaridis et al. discloses creating a file corresponding to the information; and writing the file to a mail spoon directory of the computer; and wherein the step of transmitting the electronic mail message comprising transmitting the electronic mail message corresponding to the information using the file stored in the mail spool directory (see col. 7, lines 35-37).

30. Regarding to claims 22, 44, Lazaridis et al. discloses creating and writing comprising creating a plurality of files and writing the plurality of files in the mail spool directory; and transmitting the electronic mail message using each of the plurality of files stored in the mail spoon directory (see col. 7, lines 31-40).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Kuwabara – Chapman) in view of Miyachi (U.S. Patent No. 6,108,492).

Regarding to claims 49, 53, the combined system (Kuwabara – Chapman) discloses the limitations of claim 18, 40 above.

However, the combined system (Kuwabara – Chapman) is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

Both Kuwabara, Chapman, and Miyachi disclose the office device. Miyachi discloses the business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined

Art Unit: 2664

system (Kuwabara – Chapman) with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUONG T. HO whose telephone number is (571) 272-3133. The examiner can normally be reached on 8:00 am to 4:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2664

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/11/05



WELLINGTON CHIN
SENIOR PATENT EXAMINER